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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,557	06/29/2001	Andrew V. Anderson	42390.P9765X	6490

7590

05/20/2004

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EXAMINER
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JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 05/20/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/895,557

Applicant(s)

ANDERSON ET AL.

Examiner

Bunjob Jaroenchonwanit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8.9</u> | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

1. This action has been reviewed; the objections and rejections cited are as stated below.
2. Applicant is required to submit a mark-up for a continuation-in-part application showing the subject matter added where there is an intervening reference (See. MPEP 704.11(a)(K).)

#### *Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-4, 7, 9-14, 17 19-21, 23-27, 29-31, 33 and 35 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over

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claims 1, 3-6, 11, 14, 16-19, 26 and 28 of copending Application No. 09/865,919. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instance claims merely adding threshold for determining importance of the event, without specifying how the threshold is derived, such limitation reading event subject comparison.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3-7, 11, 13-17, 21-30, 34-36 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by Horvitz et al (US.2003/0046421).

7. As to claims 1, 3, 6, 11, 13, 16, 21-25, 27-29 and 34, Horvitz discloses a methodology that is applicable for constructing computer instructions to function as a system for routing messages on priority bases in a computer system, comprising means and steps for:

receiving information of an event, (Fig. 1, Fig. 27);

determining the level of importance of the event relative to a first person (paragraphs 9, 11, 14-15, 65); and

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if the event has level of importance greater than a first threshold, and a level of importance that is below a second predetermined threshold, then taking action without contact any person (the system employed threshold level for determining appropriate actions to be taken, e.g., such as sending notification without contact any one when threshold level is greater than 85 and less than maximum or send notification without contact any person when threshold level equal or higher than 95 and equal or below maximum, Fig. 23-26; paragraphs 17, 74-75, 83 and 105).

8. Regarding claims 4, 5, 14, 15, 35, Horvitz disclose user activity includes locate user whereabouts (Fig. 34; paragraphs 2262-2264).

9. Regarding claims 7, 17, 26 and 30, Horvitz discloses, referring to information concerning the user's preferences to determine if the first person would prefer that action be taken on behalf of the first person to respond to the event without contact any person (paragraphs 10, 70 and 79).

10. As to claims 10 and 20, Horvitz discloses, referring to information exceptions to those rules (user-profile allow user to exclude message to be delivered, Horvitz, Fig. 14-16).

11. Regarding claim 36 and 38, Horvitz teaches using threshold to determine importance level of an event, based on the outcome, decides whether to take further action such as forward message, notifying a person as discussed above. Hence determining whether opportunity exists for taking action is inherent feature.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2, 12, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz et al (US.2003/0046421), in view of what was well known in the art.

14. As to claims 2, 12, Horvitz discloses the invention substantially, but fails to include determining importance level by comparing subject of message with a list of subject. Official Notice is taken that level of determining level of importance by comparing subject with a list of subject of interest was well known and widely utilized in messaging communication art, e.g., e-mail filtering or messages subscribing system, in which allows its subscribers to specify the subject of interest in their profile for future comparison.

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made that to modify level of importance determination by including well known technique in the art to expand the utility of the system.

15. Claims 8-9, 18-19, 22 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz et al (US.2003/0046421).

16. Regarding claims 8-9, 18-19, 22 and 33, Horvitz discloses the invention substantially, as claimed, as described in their base claims, but does not explicitly teach, determining importance level includes consideration whether an earlier attempt was made to contact a person or rule permit action to be taken. However, such limitation is a variation of factors, which could be easily specify within scope of Horvitz teaching to perform a desirable task without modifying conceptual design. Thus, specifying detail factors as claimed, would have been obvious to one

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of ordinary skilled in the art at the time of the invention was made that was a matter of implementation choice, which an artisan could have used the system as taught by Horvitz to do so.

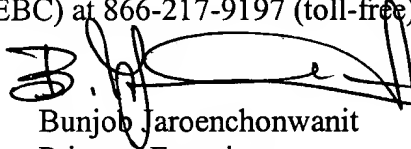
17. Regarding claims 37 and 39, Horvitz discloses the invention substantially, as claimed, as described in their base claims, including substantially as described in their base claims including, inherently teaches ceasing to take action, since the action taking is dictated by level of threshold. Horvitz does not explicitly disclose the system include logging inaction event. Official notice is taken that logging information were notorious at the time of the invention was made. Thus, to include a well known event logging for record action taken event would have been obvious to one of ordinary skilled in the art, because such inclusion would simplify system's activity analysis.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bunjob Jaroenchonwanit  
Primary Examiner  
Art Unit 2143

/bj  
5/17/04